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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,042	03/25/2004	Andrew Michael Duggan	CRUI/0012	5804

7590 09/13/2006
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EXAMINER

WOLFE, DEBRA M

ART UNIT PAPER NUMBER

3725

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,042

Applicant(s)

DUGGAN ET AL.

Examiner

Debra Wolfe

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 22, 23, 25, 29-38, 42-45, 49, 52, 53, 56-60, 63-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/05/2006.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 20,21,24-28,39-41,46-48,50,51,54,55,61,62 and 71-89.



DETAILED ACTION

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/618419, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. There is a lack of support in the parent case (No. 10618419) for the claimed subject matter of an expansion device capable of inducing both a hoop stress and compressive yield within a tubing. In addition the disclosure of the prior-filed foreign applications, GB 0306774.1 filed March 25, 2003 and GB 0312278.5 filed May 29, 2003, fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Accordingly, claims 1-19, 22, 23, 29-38, 42-45, 49, 50, 52, 53, 56-60 and 63-70 are not entitled to the benefit of the prior applications, US 10618419 filed July 11, 2003, GB 0306774.1 filed March 25, 2003 and GB



0312278.5 filed May 29, 2003. A filing date of July 9, 2003 is the earliest filing date awarded for this application.

Election/Restrictions

Applicant's election without traverse of Group 1 and Species 1 drawn to claims 1-19, 22, 23, 25, 29-38, 42-45, 49, 50, 52, 53, 56-60 and 63-70 in the reply filed on July 5, 2006 is acknowledged.

Claim 50 is withdrawn from consideration for containing subject matter directed to a nonelected species. The locking assembly is disclosed with reference to figure 7 of species III. Therefore, claim 50 has not been considered in the prosecution of this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what applicant means by the limitations "a compliant expansion member" and "a compliant cone" further clarification is needed to better understand the scope of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –



(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19, 22, 23, 25, 29-36, 42-45, 49, 52, 53, 56-60 and 63-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson (US Patent No. 6,457,532). Simpson discloses an expansion device (300) having an expansion member (116) adapted to expand a tubing by inducing a compressive yield and an expansion member (310) adapted to expand a tubing by inducing a hoop stress in the tubing. It is inherent that the radial forces applied to the tubing by the expansion member (310) to expand the tubing circumferentially with induce a hoop stress in the tubing. Simpson further discloses the hoop stress (310) and compressive yield (116) expansion members are arranged according to the desired post expansion diameter in the tubing [See col. 13] and are spaced alternately in an axial direction and a circumferential direction. The hoop stress inducing expansion members (310) and the compressive yield inducing expansion members (116) are provided on separate portion coupled together wherein a hoop stress inducing tool (302) carries the hoop stress expansion members (310) and the compressive yield inducing tool (304) carries the compressive yield expansion members (116) and are coupled by a connector stub (306). The hoop stress inducing expansion members (310) are fixed relative to a remainder of the device (300) and are integrally formed with a body of the expansion device (300). The hoop stress members are rotatable with respect to the tubing and rotatably mounted on a body of the device (300). The compressive yield inducing expansion members (116) comprise of a rotary expansion member that rotates about an expansion axis and is mounted on a spindle (118). The compressive yield expansion members (116) are radially movable mounted with respect to the body of the device (300) for movement towards an expansion configuration by applied fluid pressure. The compressive yield inducing expansion member is adapted to generate



a drive force on the tubing for at least partly translating the device (300) with respect to the tubing, the drive force is generated by rotation of the expansion device in addition to external axial force. [See col. 13 lines 20-44] The compressive yield inducing expansion members (116) is adapted to expand the tubing by less than 50% or 25% or 10% of the total expansion of the tubing [See col. 14 line 1-9]. It is noted that claims 2-5 and 16-19 do not further limit the structure of the expansion device but the disclosure of Simpson meets the required criteria of the claimed subject matter. [See FIGS 20-24 and col. 12 line 27- col. 14 line 9]

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra Wolfe whose telephone number is (571) 272-1904. The examiner can normally be reached Monday - Thursday 6am - 3:30pm with alternating Friday 6am - 2:30pm.

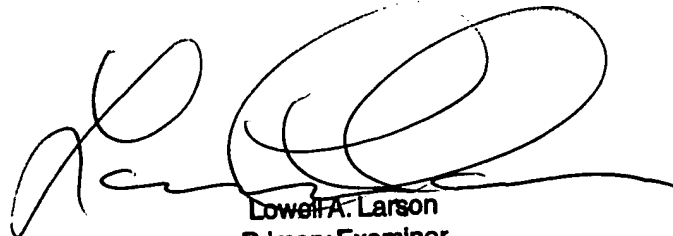
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Lowell A. Larson
Primary Examiner

Debra Wolfe
Examiner
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